

## REMARKS

Claims 1 - 8 are pending in the present application. The Examiner rejects Claims 1 - 8 under 35 U.S.C. §112, first paragraph, as allegedly failing to comply with the written description requirement.

### **The Claims Comply with the Written Description Requirement**

In the response filed on 7/5/05, the Applicants provided the Declaration of Dr. Allen Comer. Dr. Comer's declaration states that a number of irritant responsive genes and promoters were known as of the March 2001 priority date of the application. The Applicants further distinguish the present case from *Eli Lilly* in that the Applicants have provided factual evidence of what was known to those of skill in the art and the fact that the present invention claims a method of use, rather than compositions of matter<sup>1</sup>. In the present Office Action, the Examiner fails to consider the Declaration of Dr. Comer. The Examiner further fails to rebut the Applicants' arguments of record summarized above. The Examiner has simply repeated his earlier arguments as to why the Claims allegedly lack written description. The Applicants respectfully disagree.

The Federal Circuit has stated time and time again that rebuttal evidence of one skilled in the art cannot be dismissed by the Office without consideration. The Examiner must respond to all of the arguments and evidence presented by Applicants. The MPEP states that:

**Office personnel should consider all rebuttal arguments and evidence presented by applicants.** . . . *In re Beattie*, 974 F.2d 1309, 1313, 24 USPQ2d 1040, 1042-43 (Fed. Cir. 1992). . . . **Office personnel should avoid giving evidence no weight**, except in rare circumstances. *Id. See also In re Alton*, 76 F.3d 1168, 1174-75, 37 USPQ2d 1578, 1582-83 (Fed. Cir. 1996).

In *In re Alton*, the applicants submitted a declaration in order to rebut a *prima facie* case of inadequate written description by the Board of Appeals in an earlier appeal. *Id.* at 1173. Instead of addressing the arguments presented in the declaration, the Examiner dismissed the declaration as opinion evidence that was entitled to little weight. *Id.* at 1173-745. The Federal Circuit remanded the case to the Board, holding that the Board committed error in both viewing the declaration as opinion evidence and dismissing the declaration "without an adequate

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<sup>1</sup> The Applicants' arguments are not repeated in detail here but can be found in the response to Office Action submitted by the Applicants on 7/5/05.

explanation of why the declaration failed to rebut the Board's *prima facie* case" of unpatentability. *Id.* at 1174. These bases for reversal were independent. With respect to failure to provide an adequate explanation of why the declaration failed to rebut the *prima facie* case, the Federal Circuit found that:

In sum, the examiner dismissed the Wall declaration and provided only conclusory statements as to why the declaration did not show that a person skilled in the art would realize that Alton had possession of the claimed subject matter in 1983.


*Id.* at 1176. In particular, the Federal Circuit held that the examiner failed to address specific points made in the declaration concerning modifications of the amino acids sequence of protein. *Id.*

*In re Alton* is directly applicable to the present facts. Instead of addressing the arguments presented in the Comer Declaration, the Office has provided only conclusory statements and failed to address the particular evidence offered in the Declaration. As a result, Applicants respectfully request that the Examiner reconsider the evidence offered in the Comer Declaration.

### CONCLUSION

All grounds of rejection and objection of the Office Action of September 20, 2005 having been addressed, reconsideration of the application is respectfully requested. It is respectfully submitted that the invention as claimed fully meets all requirements and that the claims are worthy of allowance. Should the Examiner believe that a telephone interview would aid in the prosecution of this application, Applicant encourages the Examiner to call the undersigned collect at (608) 218-6900.

Dated: 12/19/05



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